

REMARKS

Claims 1-12, 14 and 18-22 are pending in this application. Claims 13, and 15-17 were previously cancelled further to the Response submitted May 20, 2008. Claims 12 and 18-22 have been withdrawn by the Examiner for being directed to non-elected subject matter. Claims 1 and 6 are amended to remove the term "hydrogen" and claim 4 is amended to be an independent claim. Applicants submit that no new matter has been added by these amendments. Applicants would like to thank the Examiner for withdrawing the objections to claims 1 and 10, the rejection of claims 2 and 4 under 35 U.S.C. § 112, second paragraph and the rejection of claims 1 and 5-10 under 35 U.S.C. § 103(a) over European Application No. EP 1,329,454.

I. Restriction Requirement

The Examiner maintains the finality of the restriction requirement of November 14, 2007. Applicants maintain that the pending claims conform to the unity of invention requirement under 37 C.F.R. § 1.475 for the reasons of record. Although Applicants in no way concede that the requirement is proper, Applicants are retaining all of the claims for possible rejoinder upon the allowance of the compound claims.

The Examiner has included claims 20 and 22 among the method of treatment claims. Office Action at 2. However, claims 20 and 22 are true composition claims and would not require an additional search beyond that required for claim 1. Accordingly, Applicants respectfully request that claims 20 and 22 be examined in this application.

The Examiner states on page 3 of the Office Action that "[i]f Applicant would like rejoinder of the process claims and the method claims, Applicant is entitled to elect a single disclosed method, not multiple methods." *Id.* Based on the unity-of-invention rules, Applicants understand that Applicants are entitled to the examination in this

application of the product claims (currently under examination), a process for the manufacture of the product (claim 12), and a process of using the product. See 37 C.F.R. § 1.475. Regarding the method of treatment claims, Applicants elect claim 19 as the initial claim on which the Examiner can focus her examination. However, Applicants request that the Examiner continue to examine the full scope of the claims to the extent necessary to determine the patentability of the pending claims. See M.P.E.P. § 821.04 and 35 U.S.C. § 121.

II. **Claim Objections**

The Examiner objects to claims 7 and 11 for “being dependent upon a rejected base claim.” Office Action at page 4. Claims 7 and 11 ultimately depend from claim 1, which has been amended herein. Applicants believe that the amendment made to claim 1 places claim 1 in condition for allowance, and therefore, claims 7 and 11 are also allowable. Accordingly, Applicants respectfully request that this objection be withdrawn.

III. **Rejections under § 112**

A. **Second paragraph**

The Examiner maintains the rejection of claim 4 under 35 U.S.C. § 112, second paragraph for “insufficient antecedent basis” for the term “dialkylamino” in the definition of R₂. Office Action at page 5. Although Applicants disagree with the rejection, Applicants have amended claim 4 to be an independent claim. Support for the term “dialkylamino” in the definition of R₂ in claim 4 is fully supported in original claim 4 and in the specification at page 4. ll. 4-8, where it is stated that R₂ can be chosen from an alkyl group substituted by a mono-alkylamino group, thus providing sufficient support for the

R₂ substituent in claim 4. For at least these reasons, Applicants respectfully request that this rejection be withdrawn.

B. First paragraph

The Examiner maintains the rejection of claims 1-6, 8-10, and 14 under 35 U.S.C. § 112, first paragraph “because the specification . . . does not reasonably provide enablement for compounds of Formula I, wherein R₄ is H.” *Id.* at page 6. Applicants disagree with this rejection because the Examiner has not shown that one of ordinary skill in the art would not be able to prepare compounds of the invention when R₄ is hydrogen. However, in an effort to expedite prosecution, the term “hydrogen” has been deleted from claims 1 and 6, thus rendering the rejection of claims 1-6, 8-10 and 14 moot. Accordingly, Applicants respectfully request withdrawal of the rejection.

IV. Conclusion

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-12, 14 and 18-22 in condition for allowance. Applicants submit that the proposed amendments of claims 1, 4 and 6 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

Applicants therefore request the entry of this Amendment, the Examiner's reconsideration of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By: 
Carlos M. Tellez
Reg. No. 48,638
(202) 408-4123

Dated: November 4, 2008